



I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

On 12 Oct. 2005

TOWNSEND and TOWNSEND and CREW LLP

By: Malinda Adgett

PATENT

Attorney Docket No.: 021362-000300US
Client Ref. No.: LAD-2001-095/S#97,780

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Andrew Bradbury
Geoff Waldo

Application No.: 10/670167

Filed: September 23, 2003

For: USE OF TEMPLATED SELF
ASSEMBLY TO CREATE NOVEL
MULTIFUNCTIONAL SPECIES

Customer No.: 20350

Confirmation No. 2827

Examiner: Michael Borin, Ph.D.

Technology Center/Art Unit: 1631

RESPONSE TO RESTRICTION
REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the restriction requirement set forth in the Office Action mailed September 12, 2005, applicants elect Group I, claims 1-17, drawn to a bifunctional polypeptide.

In response to the species election requirement, Applicants elect antibody as the species of binding ligand, and fluorescent dye as the species of reporter molecule. The claims in elected Group I that read on the binding ligand species are claims 1-5 and 8-17. The claims in elected Group I that read on the fluorescent dye species are claims 1-7 and 11.

The foregoing election is made with traverse. According to the MPEP, where claims can be examined together without undue burden, the Examiner must examine the claims

on the merits even though they are directed to independent and distinct inventions. See, the MPEP at 803.01. In establishing that an “undue burden” would exist for co-examination of claims, the Examiner must show that examination of the claims would involve substantially different prior art searches, making the co-examination burdensome. To show undue burden resulting from searching difficulties, the Examiner must show that the restricted groups have a separate classification, acquired a separate status in the art, or that searching would require different fields of search (MPEP at § 808.02).

In the present case, Groups I and II are in the same search classification, Groups II and IV are in the same classification, and Groups VI-IX are in the same search classification. Further, a proper search of Group I, likely identifies the individual components assembled together in a kit (Group III). Further, the claims of Groups VI and VII, drawn to methods of screening involving a bifunctional polypeptide, can be examined with Group I claims without undue burden as a search of the art relating to Group I would necessarily identify art related to these claims.

In view of the foregoing, Applicants respectfully submit that all of the inventions in the present application can readily be searched without undue burden and therefore request withdrawal of the restriction requirement. At a minimum, Applicants request rejoinder of method claims 56 and 57 upon identification of allowable product claims (see, the MPEP § 821.04).

Further, with regard to the species election requirement, the Examiner is reminded that upon allowance of a generic claim, applicants are entitled to consideration of claims to additional non-elected species which depend from the allowed generic claim (MPEP § 809.02).

Appl. No. 10/670167

Response to restriction dated October 12, 2005

Reply to Office Action of September 12, 2005

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. Lockyer', with a long horizontal flourish extending to the right.

Jean M. Lockyer
Reg. No. 44,879

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
JML:jml
60608426 v1